

REMARKS

Status of the Claims

In the Office Action mailed September 26, 2003, claims 36-38 and 68-71 were noted as pending in the application. Claims 36 and 68 were rejected. Claims 37, 38 and 69-71 were objected to as being dependent on rejected base claims.

Rejection of Claims 36 and 68 under 35 U.S.C. § 102(e).

Facts

On page 2, item 4 of the office action, Examiner rejected claims 36 and 68 under 35 U.S.C. § 102(e). The reference cited is U.S. Patent No. 6,028,860 to Laubach, *et. al.* (“‘860”).

Examiner rejected claims 36 and 68 as being anticipated under 35 U.S.C. § 102(e), asserting that all of the elements of the rejected claims are disclosed in the reference. Examiner pointed out with particularity where in the reference each of the rejected claims’ elements is allegedly disclosed. All of the inventors of the present application are also inventors listed in ‘860. A copy of the declaration in the present application is enclosed. There is one additional inventor, Michael J. Sabin, listed in ‘860 who is not listed as an inventor in the present application. All of these inventors, including Mr. Sabin, were employed by Com21, Inc., of Milpitas, California, at the time the application that resulted in ‘860 was filed.

Law

Under Federal Circuit Court of Appeals precedent, “[e]ven though an application and a patent have been conceived by different inventive entities, if they share one or more persons as joint inventors, the 35 U.S.C. § 102(e) exclusion of a patent granted to ‘another’ is not necessarily satisfied.” Applied Materials, Inc. v. Gemini Research Corporation, 835 F.2d 279, 281 (Fed. Cir 1987). In Applied Materials, the patent under review (‘313 patent) and the patent (‘712 patent) cited against it “grew from the same original application.” Id. Accordingly, the court determined that “if the invention

claimed in the '313 patent is fully disclosed in the '712 patent, this invention had to be invented before the filing date of the '712 patent and that latter cannot be 102(e) prior art to the '313 patent." *Id.* Citing In re Land, 368 F.2d 866, 879 (CCPA 1966), where the claims of two joint inventors had been rejected under 102(e) as being anticipated by patents of each of the inventors individually, the court pointed out that "[w]hen the 102(e) reference patentee ['712] . . . had knowledge of the joint applicants' invention ['313] by being one of them, and *thereafter* describes it, he necessarily files the application ['712] after the ['313] applicant's invention date" (emphasis in original).

In short, the Federal Circuit and its predecessor Court of Customs and Patent Appeals has held that when the inventors of a later-filed application were also inventors of an earlier-filed application that matured into a patent, and subject matter that supports rejected claims in the later filed application is disclosed in the specification of the earlier-filed patent application, the invention claimed necessarily cannot have been invented after the filing date of the earlier-filed patent application. Therefore, the earlier-filed application/patent cannot be prior art to the later-filed application. See 1 Chisum, Chisum on Patents § 3.08[2][a], at 3-156.2.

This holding was not reversed in the recent Federal Circuit case Purdue Pharma L.P. v. Boehringer Ingelheim Corporation, 237 F.3d 1359 (Fed. Cir. 2001) (Purdue Appeal). In Purdue, the court discussed that Purdue argued and the district court held that the asserted prior art ('331 patent) was not prior art, although the inventive entities differed, "because the inventions disclosed in the patents-in-suit were conceived and reduced to practice before the filing date of the '331 parent application." At trial, Purdue argued that the case should be governed by Applied Materials. Purdue Pharma L.P. v. Boehringer Ingelheim Corporation, 98 F. Supp. 2d 362 (S.D.N.Y. 2000) (Purdue Trial). For the defendant's to prevail, Purdue argued, every element of the claims in the patents in suit would have to be disclosed in the alleged prior art. *Id.* at 381. Therefore, assuming this to be true, "Applied Materials is directly applicable to the present case, since (1) the inventive entities of the respective patents overlap, and (2) the additional inventor named in the later patent had knowledge of the later invention at the time of the parent patent application." *Id.* The district court concurred, stating that "Purdue's reading

is the simplest and most obvious interpretation of the decision, and rejection of [defendant's] anticipation defense is appropriate on this basis alone.” Id.

The Federal Circuit went on to affirm that the district court did not abuse its discretion in holding that, under the rule of reason, a group of documents, including graphs and related textual documents provided adequate proof of conception and reduction to practice before the filing date of the ‘331 patent. Purdue Appeal at 1366. Although the Federal Circuit did not directly address the applicability of Applied Materials, it is reasonable to infer that such applicability was tacitly approved. The trial court specifically stated that it believed that the Federal Circuit’s holding in Applied Materials was applicable because “the Federal Circuit rendered the decision in response to an anticipation defense and most likely had principles of anticipation in mind when it discussed the fact that the later invention was “fully disclosed” in the parent patent application.” Purdue Trial at 381. Because the appeals court did not reject this belief of the trial court, the Purdue decisions and Applied Materials, therefore, stand for the proposition that when there is an overlap in inventorship between a earlier-filed application that matured into a patent and a later-filed application, and the invention claimed in the later-filed application is disclosed in the earlier-filed application, the patent cannot be prior art to the later-filed application because the inventor(s) thereof would necessarily have conceived and reduced to practice the claimed invention prior to filing the earlier-filed application.

Whether a patent is prior art to an application having a different inventive entity turns on “what the evidence of record shows as to who invented the subject matter.” MPEP § 2136.05 (citing In re Whittle, 454 F.2d 1193, 1195). Therefore, when unclaimed subject matter of a patent is an applicant’s own work, applicant can overcome a 102(e) rejection by showing that the cited patent is a description of applicant’s own previous work. MPEP § 2136.05, (citing In re Mathews, 408 F. 2d 1393 (CCPA 1969)). “Such a showing can be made by proving that the patentee was associated with applicant (e.g. worked for the same company) and learned of applicant’s invention from applicant. Id. Furthermore, the filing of an enabling disclosure in a patent application is considered a constructive reduction to practice of a described invention. MPEP § 2138.05, (citing Hyatt v. Boone, 146 F.3d 1348 (Fed. Cir. 1998)). “Thus the inventor need not provide

evidence of either conception or actual reduction to practice when relying on the content of the patent application.” Id.

Analysis

The ‘860 patent is not prior art to the present application. According to MPEP § 2136.05 cited above, the patentees of ‘860 were associated with the applicants of the present application before the application for ‘860 was filed since they all worked for the same company at the time the ‘860’s application was filed. Therefore, the patentees learned of the applicant’s invention from the applicant.

Because Examiner has rejected claims 36 and 68 as being anticipated under 35 U.S.C. § 102(e) by ‘860, Examiner thereby necessarily implies that the elements of these claims are enablingly disclosed in ‘860. Therefore, per MPEP § 2138.08, at the latest, the inventions claimed in rejected claims 36 and 68 were reduced to practice, and thus invented, simultaneously with the filing of the application that matured into ‘860. Accordingly, the application that matured into ‘860 could not have been filed before the inventions claimed in claims 36 and 68, as is required by 35 U.S.C. § 102(e) to preclude patentability.

This is similar to the line of reasoning that was used in the Purdue cases, which was based on the Applied Materials case cited above. As the Applied Materials court held, “if the invention claimed in the [present application] is fully disclosed in the ‘[860] patent, this invention [of the present application] had to be invented before the filing [] of the ‘860 patent and, [therefore], that latter cannot be 102(e) prior art to the [present application].” 835 F.2d 279, 281.

As discussed above, Examiner stated that the elements of the rejected claims are disclosed in ‘860, because the claims were rejected as being anticipated thereby. Even assuming, for the sake of argument, that Mr. Sabin contributed some part to the ‘860 patent, this subject matter necessarily cannot be subject matter claimed in the present application, since he is not an inventor listed in same. Accordingly, under MPEP § 2136.05, the rejection is overcome because the ‘860 patent describes previous work of the inventors of the present invention.

Therefore, under the M.P.E.P and Federal Circuit precedence, the '860 patent cannot be prior art to the present application.

Alternatively, if all of the elements of the rejected claims are not disclosed in the '860 patent, then the rejected claims cannot be anticipated thereby because all of the claim elements are not found in the cited reference.

Accordingly, Applicant has demonstrated that '860 is not prior art to the present invention, or, alternatively, even if it were, it cannot anticipate the rejected claims. Thus, claims 36 and 68 patentably distinguish over the cited reference and withdrawal of the rejection is respectfully requested.

SUMMARY

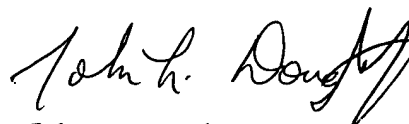
For all the reasons advanced above, Applicant respectfully submits that the application is in condition for allowance and that action is earnestly solicited.

If the Examiner believes that there are any issues that can be resolved by a telephone conference, or that there are any informalities that can be corrected by an Examiner's amendment please contact the undersigned at the mailing address, telephone, facsimile number, or e-mail address indicated below.

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Respectfully submitted,

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